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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, QUANG

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 03/11/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/865,022

Applicant(s)

HEBBEL ET AL.

Examiner

Quang Nguyen

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to a process for expanding a population of endothelial cells obtained from peripheral blood, classified in class 435, subclass 325.
- II. Claims 15-26 are drawn to a transgenic mammalian endothelial cell comprising an isolated DNA sequence encoding a recombinant Factor VIII protein or a preselected protein, a pharmaceutical composition comprising the same and a method for treating hemophilia using the same, classified in class 424, subclass 93.21.
- III. Claims 27-32 are drawn to an implantable medical prosthetic device comprising a surface coated with endothelial cells comprising an isolated DNA sequence encoding a preselected protein operably lined to a promoter functional in human endothelial cells, classified in class 623, subclasses 1, 2, 11, for examples.
- IV. Claims 33-36 are drawn to a diagnostic method comprising detecting or determining whether an expanded population of endothelial cells obtained from a test mammal has an acquired or genetic indication or disease relative to a control expanded population of endothelial cells obtained from a mammal not at risk of the acquired or genetic indication or disease, classified in class 435, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05 (h)). In the instant case, the process of invention I can be used with non-transgenic mammalian endothelial cells.

Inventions I and III are mutually exclusive and independent. The process of invention I is not required for the invention III, and vice versa.

Inventions I and IV are distinct methods that involve different method steps and desired end-results. For example, the method of Invention I does not require any step(s) for detecting or determining any population of endothelial cells having or acquiring any disease, and merely for expanding a population of endothelial cells obtained from peripheral blood. In effect, the method of Invention I is not a diagnostic method as of Invention IV.

Inventions II and III are drawn to distinct products. The transgenic mammalian endothelial cell of Invention II is not physically or chemically the same as an implantable medical prosthetic device of Invention III.

Inventions II and IV are mutually exclusive and independent. The transgenic mammalian endothelial cell of Invention II is not required for the diagnostic method of Invention IV, and vice versa. Furthermore, the transgenic endothelial cell of Invention II can be used in a method for treating hemophila.

Inventions III and IV are mutually exclusive and independent. The implantable medical prosthetic device of Invention III is not required for the diagnostic method of Invention IV, and vice versa.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and separate search requirements, it would be unduly burdensome for the examiner to search and/or consider the patentability of all the inventions in a single application. Therefore, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17 (h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (703) 308-8339.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, Dave Nguyen, may be reached at (703) 305-2024, or SPE, Irem Yucel, at (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tracey Johnson, whose telephone number is (703) 305-2982.

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To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1636.

Quang Nguyen, Ph.D.



DAVE T. NGUYEN  
PRIMARY EXAMINER